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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,196	01/29/2004	Anthony Balloutine	390.0002	2257
25534 7590 02/01/2007 CAHN & SAMUELS LLP 2000 P STREET NW SUITE 200 WASHINGTON, DC 20036			EXAMINER SUHOL, DMITRY	
			ART UNIT	PAPER NUMBER
			3725	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/01/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/766,196

Applicant(s)

BALLOUTINE, ANTHONY

Examiner

Dmitry Suhol

Art Unit

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumano et al (JP 05-193249) in view of Sherman '849. Kumano discloses a sheet having indicia printed there on which disappear over time when in contact with vapor, oxygen or ultraviolet rays in air (see abstract) as required by claim 1. Kumano further teaches that his sheet may carry a variety of indicia including letters/characters, charts, pictures or other indicia as desired (see abstract and paragraph 0001 of translation), where for purposes of claim 1 letter characters are considered to be penmanship improving indicia.

Kumano lacks the teaching of an overlying barrier sheet (as required by claim 1) being of a synthetic polymer (as required by claim 2) or a lightweight aluminum foil (as required by claim 3). However, Sherman discloses a device which has indicia that disappears over time when in contact with air (much like Kumano) which teaches the use of an overlying barrier sheet (10). Therefore it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention, to have

manufactured the sheet of Kumano with an overlying barrier sheet of Sherman for the purpose of not starting the disappearing reaction until the desired time.

Regarding the material of manufacture of the cover, as required by claims 2 and 3, it would have been obvious to utilize a cover made of a synthetic polymer or lightweight aluminum foil since Sherman does not put forth any constraints regarding the materials used in the manufacture of his barrier (10) but that the barrier prevents air or light from reaching the reactive ink of his invention and the use of any of the above materials would be capable of fulfilling such a function. Furthermore, the specific materials of manufacture of the barrier sheet of applicants invention are considered to be a design choice in that applicants clearly admit that (much like Sherman) any materials may be used with the only constraint being that the barrier prevent the ink from being exposed to air (see applicants specification page 5, lines 3-9).

Regarding the instructions as required by claim 5, it would have been obvious to include a series of instructions located on the barrier sheet as taught by Sherman for the purpose of providing instructions to the user of the device especially since the examiner takes official notice that such construction is conventional (i.e. peel back covers often have instructions stating items like "peel back here", or "pull up and peel back", etc).

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kumano et al (JP 05-193249) and Sherman '849, as stated above, and further in view of Pitts et al '297. Kumano, as modified by Sherman, lacks the explicit teaching that his indicia is a

plurality of lines as required by claim 4, however Pitts teaches that it is known to provide a sheet substrate with guide lines that facilitate penmanship and are later removed (col. 1, lines 14-23. Therefore it would have been obvious to include the guide indicia of Pitts with the sheet of Kumano, as modified by Sherman, for the purpose of providing a sheet with guide indicia for writing, especially since Kumano envisions a wide variety of indicia with his sheet (paragraph 0001 of translation).

### ***Response to Arguments***

Applicant's arguments filed 11/15/2006 have been fully considered but they are not persuasive. Applicants argue that the Kumano fails to teach "a marking area comprising penmanship improving indicia comprising ink capable of disappearing" since, according to the applicants, Kumano is drawn to the function of recycling a misprinted sheet. In response the examiner points out that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case Kumano clearly discloses a paper sheet substrate which may contain a variety of indicia including alphabetic characters produced by ink which disappears when reacted with vapor, oxygen or UV light (see abstract). Furthermore, as broadly claimed by the applicants "penmanship improving indicia" is read onto the alphabetic characters since such characters can clearly fulfill such a function (i.e. children often learn/practice penmanship by looking at alphabetic characters and

Art Unit: 3725

practicing recreating them on paper or other substrate). It is therefore the examiners position that a marking area (considered to be any area in the proximity of the indicia) comprising penmanship improving indicia (alphabetic characters) comprising ink capable of disappearing (see abstract) is clearly taught by Kumano.

Applicants further appear to argue that the examiner has broadly stated that the indicia to be displayed is not patentable and since the combination of Sherman and Pitts was found to be inappropriate in the Pre-Appeal review such a position is not correct in this case. In response the examiner points out that no mention of In re Gulack has been made in this rejection since Kumano already discloses the indicia as broadly claimed by the applicants (see above).

Applicants further argue that the examiner has not articulated a clear rationale as one of ordinary skill in the art would be motivated to achieve the claimed penmanship improving indicia. In response the examiner points out , with respect to claim 1, that as broadly claimed by the applicants Kumano reads on the claimed penmanship indicia and no modification has been made. However if applicants are referring to the limitations of claim 4 and the addition of the Pitts reference then, as stated above, it would have been obvious to include the guide indicia of Pitts with the sheet of Kumano, as modified by Sherman, for the purpose of providing a sheet with guide indicia for writing, especially since Kumano envisions a wide variety of indicia with his sheet (paragraph 0001 of translation).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

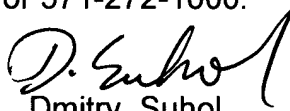
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 571-272-4430. The examiner can normally be reached on Mon - Friday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lowell Larson can be reached on (571) 272-4519. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3725

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Dmitry Suhol  
Primary Examiner  
Art Unit 3725

ds